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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/631,869	08/02/2000	Raymond J Sabbagh	D/A0105	8927

7590

06/30/2003

John E. Beck  
Xerox Corporation Xerox Square - 20A  
Rochester, NY 14644

EXAMINER
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NOLAN JR, CHARLES H

ART UNIT	PAPER NUMBER
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2854

DATE MAILED: 06/30/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/631,869

Applicant(s)

SABBAGH ET AL.

Examiner

Charles H Nolan, Jr.

Art Unit

2854

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 03 June 2003.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1,3-18 and 21-27 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☐ Claim(s) \_\_\_\_\_ is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☒ Claim(s) 23-27 are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 02 June 2000 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. §§ 119 and 120**

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)                      4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)                      5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_                      6) ☐ Other: \_\_\_\_\_

### ***Claim Objections***

A. The numbering of claims is not in accordance with 37 CFR 1.126 which requires the original numbering of the claims to be preserved throughout the prosecution. When claims are canceled, the remaining claims must not be renumbered. When new claims are presented, they must be numbered consecutively beginning with the number next following the highest numbered claims previously presented (whether entered or not).

Misnumbered claims 22-26 been renumbered 23-27.

### ***Claim Rejections - 35 USC § 102***

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) do not apply to the examination of this application as the application being examined was not (1) filed on or after November 29, 2000, or (2) voluntarily published under 35 U.S.C. 122(b). Therefore, this application is examined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

2. Claims 1,3,7,8,9,10,11, 13,14 are rejected under 35 U.S.C. 102(b) as being anticipated by Gase et al (5,580,177, hereinafter "Gase").

Applicant argues in the response dated 6-3-03 that the instant invention is concerned with updating the configuration of already installed printers. It is noted that the claims of the instant invention nowhere state that the instant invention is limited to the configuration of already installed printers and not new printers. As a matter of fact, the instant claims are silent as to the temporal placement of the printer in the network. Applicant is reminded that limitations in the specification are not imported into the claims. If Applicant intends on having the invention be limited to currently installed printers, the claim language should reflect that intention. "The invention disclosed in the written description may be outstanding in its field, but the name of the game is the claim." In re Hiniker Co., 47 USPQ2d 1523,1529 (Fed Cir. 1998). With respect to Claim 1, Gase teaches the monitoring step in figure 3a, element 74, the recognizing step in figure 3a, element 76 and the saving step in the Abstract, lines 4-6 or column 4, lines 12-20. The Examiner notes that the gathering step is an inherent part of Gase. Printer configuration information is typically "gathered" directly from the printer, via "Plug and Play" as implied by Gase in column 5, lines 8-12. Therefore, the Examiner's position is that the Gase reference as a whole anticipates Claim 1. Further, Gase teaches the waking and alerting steps of a printer driver already installed on the server in figure 3a, elements 74-76. With respect to Claims 7 and 13, note the rejection of Claim 1 above and the printer port of a print server 28' on the front page diagram. With respect to Claim 3, the Examiner has interpreted the term "thread" as recited in this claim to

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mean -- part --. Accordingly, Gase teaches the printer manager thread in column 6, lines 8-15. With respect to Claim 8, Gase teaches that his invention may be used with Windows operating software which is the same for the server and client in column 6, lines 53-54. With respect to Claim 9, Gase teaches the pipe server thread (part) connection between elements 28' and 28 transferring printer configuration data on the front-page diagram. With respect to Claim 10, Gase teaches the updating step in figure 3a. With respect to Claim 11, Gase teaches transferring step in Abstract, lines 9-16. With respect to Claim 14, Gase teaches the data is printer status data in figure 3b

3. Claims 1,4-6,7,11-12 are rejected under 35 U.S.C. 102(e) as being clearly anticipated by White et al (US 6,301,012 B1, hereinafter "White").

Applicant argues in the response dated 6-3-03 that the instant invention is concerned with updating the configuration of already installed printers. It is noted that the claims of the instant invention nowhere state that the instant invention is limited to the configuration of already installed printers and not new printers. As a matter of fact, the instant claims are silent as to the temporal placement of the printer in the network.

Applicant is reminded that limitations in the specification are not imported into the claims. If Applicant intends on having the invention be limited to currently installed printers, the claim language should reflect that intention. "The invention disclosed in the written description may be outstanding in its field, but the name of the game is the claim." In re Hiniker Co., 47 USPQ2d 1523,1529 (Fed Cir. 1998). With respect to Claims 1 and 7, White teaches gathering step in figure 2, element 130, the monitoring step in figure 2, element 135, the recognizing step in figure 2, element 190 and the

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saving/updating step in figure 2, element 195. Further, White teaches the waking and alerting steps for a print driver already installed on the network (server) in figure 3, elements 150,160,175,180 and 185. With respect to Claim 4, White teaches the polling step when a new printer is installed in figure 2, element 135 and the comparing step in figure 2, element 190. With respect to Claim 5, it is noted that White teaches that comparison is made with the new printer configuration data does not match the stored configuration data in figure 2 element 135 or 190. Further, White teaches that the printer driver is awakened from an already installed driver on the network(server) in figure 3, element 160. It is noted that an unavoidably necessary part of White's invention is the setting of flags to perform the procedure as outlined in figures 2 and 3. Further, it is noted that flags are simply indicators in a program to initiate some activity. The comparisons of White as illustrated in figures 2 and 3 are certainly flags (indicators) that prompt an activity of printer driver comparison and updating to the printer spooler. With respect to Claim 6, White teaches the use of the Windows Operating system to send the print driver information in column 2, lines 52-58 and figure 3, element 150. It is noted that the application program interface in figure 3 is the network program containing the drivers needed to operate the printer in that embodiment of White. With respect to Claim 11, White teaches the server thread(part) that determines the configuration options from the server registry(cache) and transfers the configuration options to the client device(spooler) in figures 2 and 3. With respect to Claim 12, White teaches the transfer of configuration options using a Windows based operating system object in figure 2-3 and column 2, lines 53-57 and column 3, lines 60-65.

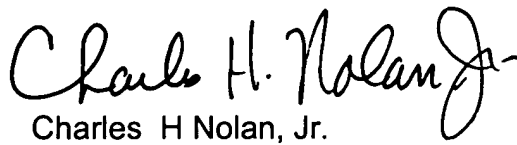
***Election/Restrictions***

4. Newly submitted claims 23-27 are directed to an invention that is independent or distinct from the invention originally claimed for the following reasons: Claims 23-27 are directed to a computer code only and not to a system as original claim 15.

Since applicant has received an action on the merits for the originally presented invention, this invention has been constructively elected by original presentation for prosecution on the merits. Accordingly, claims 23-27 are withdrawn from consideration as being directed to a non-elected invention. See 37 CFR 1.142(b) and MPEP § 821.03.

5. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Charles H Nolan, Jr. whose telephone number is 703-308-0961. The examiner can normally be reached on Monday through Thursday 8:00 AM to 6:30 PM. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Andrew Hirshfeld can be reached on 703-305-6619. The fax phone numbers for the organization where this application or proceeding is assigned are 703-308-7722 for regular communications and 703-308-5841 for After Final communications. Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0956.

CHN  
June 26, 2003

  
Charles H Nolan, Jr.  
Examiner  
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